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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/940,402 | 08/27/2001 | James J. Pagliuca | A31-5822 | 4330 |

26294 7590 08/13/2003

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EXAMINER

LEUBECKER, JOHN P

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 3739 | 3 |

DATE MAILED: 08/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|----------------------|---------------------|--|
| Office Action Summary | Applicant No. | Applicant(s) | |
| | 09/940,402 | PAGLIUCA ET AL. | |
| | Examiner | Art Unit | |
| | John P. Leubecker | 3739 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 27 August 2001.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 12-17,26-38 and 44-48 is/are allowed.
- 6) Claim(s) 1,4-6,8,18,21 and 39 is/are rejected.
- 7) Claim(s) 2,3,7,9-11,19,20,22-25 and 40-43 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

Priority

1. This application repeats a substantial portion of prior Application No. 09/821,297, filed March 29, 2001, and adds and claims additional disclosure not presented in the prior application. Since this application names an inventor or inventors named in the prior application, it may constitute a continuation-in-part of the prior application. Should applicant desire to obtain the benefit of the filing date of the prior application, attention is directed to 35 U.S.C. 120 and 37 CFR 1.78.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 4-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4, which depends from claim 2, recites that the cannula retainer includes “a sleeve”, wherein previously in claim 2 the cannula retainer also included “a sleeve” (line 6 of claim 2). It is unclear as to whether a second, different sleeve is being claimed in claim 4, or if the sleeve in claim 2 is just being redundantly referred to. Claims 5 and 6 refer to “said sleeve” but does not differentiate between which sleeve is being referred to.

Dependent claims inherit those defects.

Claim Rejections - 35 USC § 102

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4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 8 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Konomura (U.S. Pat. 5,575,754).

As to claim 1, Konomura disclose an apparatus including a base (14) having a guide portion (14a), a first part (20), a second part (15) engaging the guide portion (14a), the first and second parts being movable relative to the guide portion, and a mechanism (16,17) connected between the base and second part for moving the first and second parts relative to the guide portion. As to claim 8, the first part includes a rail member (groove 21) for slidably engaging a guide track (pin 22) of the second part. As to claim 18, Konomura disclose a base (14), a sleeve (20,20a) being relatively rotatable about an axis with respect to the base, and a sleeve retainer (15) for supporting the base and sleeve (note connection between the sleeve retainer and the base and sleeve in Fig. 2), wherein the sleeve retainer (15) includes a member (22) press fit onto an end portion (21) of the sleeve.

6. Claim 39 is rejected under 35 U.S.C. 102(b) as being anticipated by Nakajima (U.S. Pat. 4,854,301).

Referring to Figure 18, Nakajima discloses a base (188) and a sleeve (190) which is capable of engaging the outer surface of a cannula (112), the base and sleeve being relatively rotatable about an axis (col.12, lines 25-26 and 31-33). The sleeve is made of rubber and is thus inherently capable of increasing the initial internal diameter (with an applied force, i.e., insertion of a cannula) and springing back.

7. Claims 18 and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Pagliuca (U.S. Pat. 6,530,880).

Referring to Figure 9, Pagliuca discloses a base (120), a sleeve (800) being relatively rotatable relative to the base about an axis (14), and a sleeve retainer (125) for supporting the sleeve and base, the sleeve retainer including a member (420, Fig.14) press fit onto an end portion of the sleeve. As to claim 21, note index mechanism (best seen in Figure 13) for retaining the base at incremental relatively rotated positions relative to the sleeve.

Allowable Subject Matter

8. Claims 12-17, 26-38 and 44-48 are allowed.
9. Claims 2, 3, 7, 9-11, 19, 20, 22-25 and 40-43 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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10. Claims 4-6 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Komiya (U.S. Pat. 3,822,697)—note structure of Figure 1 with respect to claims 1 and 18.

Davidson et al. (U.S. Pat. 6,361,488)—note support apparatus structure (Fig.9) with respect to claim 1.

Smith et al. (Pub. 2002/0022764)—note Figures 38-50 with respect to cannula/endoscope supporting structure.

The following show other relevant supporting structures:

Costella (U.S. Pat. 4,696,544)

Flam (U.S. Pat. 5,607,386)

Cooper (U.S. Pat. 6,346,072)

Brock et al. (Pub. 2002/0087048)

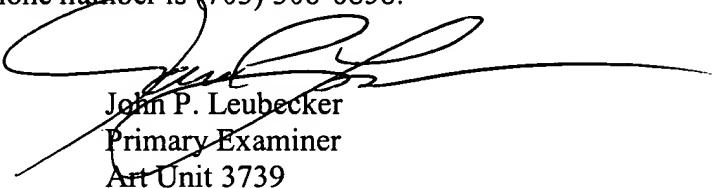
Skakoon et al. (Pub. 2002/0010479)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Leubecker whose telephone number is (703) 308-0951. The examiner can normally be reached on Monday through Friday, 6:00 AM to 2:30 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (703) 308-0994. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3590 for regular communications and (703) 305-3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.



John P. Leubecker
Primary Examiner
Art Unit 3739

jpl
August 11, 2003